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#9
12-4-02

PTO/SB/26 (10-00)
Approved for use 10/31/2002. OMB 0651-0031
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TERMINAL DISCLAIMER TO OBVIATE A DOUBLE PATENTING REJECTION OVER A PRIOR PATENT	Docket Number (Optional) P01266US (98541.2P2)

In re Application of: Daniel S. Sinclair, Jr.

Application No.: 10/083,671

Filed: 02/26/2002

For: Tobacco Product

The owner*, Blunt Wrap U.S.A., Inc, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,321,755. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record.

27 November 2002

[redacted]
Signature Date

Seth M. Nehrbass, 31,281 Attorney for Applicant
Typed or printed name

12/03/2002 VDAY11 00000002 500694 10083671
01 FC:2814 ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included.
55.00 CH

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*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner). Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

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TERMINAL DISCLAIMER TO OBVIATE A PROVISIONAL DOUBLE PATENTING REJECTION OVER A PENDING SECOND APPLICATION	Docket Number (Optional) P01266US (98541.2P2)

In re Application of: Daniel S. Sinclair, Jr.

Application No.: 10/083,671

Filed: 02/26/2002

For: Tobacco Product

The owner*, Blunt Wrap U.S.A., Inc, of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 to 156 and 173 as shortened by any terminal disclaimer filed prior to the grant of any patent granted on pending second Application Number 10/090,932, filed on 5 March 2002, of any patent on the pending second application. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and any patent granted on the second application are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of any patent granted on the second application, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record.

27 November 2002

Signature Date

Seth M. Nehrbass, 31,281 Attorney for Applicant

Typed or printed name

12/03/2002 VDAY11 00000001 500694 10083671

01 FC:2814 55.00 OP

☒ Terminal disclaimer fee under 37 CFR 1.20(d) is included.

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DETAILED ACTION

Terminal Disclaimer

1. The terminal disclaimer filed on 11-27-02 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Patents 6,321,755 and 6,357,448 and any patent granted on Application 10/090932, has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 276-278, 306-328 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willis (US. Pat. No. 191,501) in view of Cartwright et al (US. Pat. No. 4,452,257).

Willis discloses a cigar product "a", comprised of rolled tobacco leaves having a wrapper "f", with a longitudinal bore "b" (which means that it is obviously "unfilled"), which results in a hollow tube. Since the cigar product is wrapped with tobacco leaves, the edges of said leaves can obviously be moved apart, unrolled by the end user so that the bore can be accessed. The cigar product, subsequent to its production, is packaged (obviously in cellophane/clear material since this type of packaging material is conventional in many arts) and, without words to the contrary, it is assumed that the dimensions are such that the cigar product remains in its rolled configuration. While

there is no specific indication that tobacco material has a liquid additive, Cartwright et al discloses a treatment additive for natural leaf tobacco wrapper comprising humectants, preservatives, and solvent which is designed to condition the leaves to prevent the wrapper leaf from becoming brittle and lose flexibility (see col. 1, lines 5-34; see abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to add the liquid composition of Cartwright et al to the cigar product of Willis in order to improve the tobacco leaf's resistance to breakage.

4. Claim 288 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bishop (US. Pat. No. 200,889) in view of Cartwright et al (US. Pat. No. 4,452,257).

Bishop discloses a cigar wrapper, to be filled with tobacco, comprised of paper or leaf tobacco, having a tubular shape (see page 1 and figs.) Since the cigar product is wrapped with tobacco leaves, the edges of said leaves can obviously be moved apart, unrolled by the end user so that the bore can be accessed for filling of tobacco. While there is no specific indication that tobacco material has a liquid additive, Cartwright et al discloses a treatment additive for natural leaf tobacco wrapper comprising humectants, preservatives, and solvent which is designed to condition the leaves to prevent the wrapper leaf from becoming brittle and lose flexibility (see col. 1, lines 5-34; see abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to add the liquid composition of Cartwright et al to the cigar product of Willis in order to improve the tobacco leaf's resistance to breakage.

Allowable Subject Matter

5. Claims 279-280, 299-303, 329-338 are allowed.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P. Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

Dionne A. Walls
February 10, 2003

JOSE A. FORTUNA
PRIMARY EXAMINER

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 276-278, 288, and 306-338 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,357,448 in view of Eilerman et al (US. Pat. No. 5,147,463).

The claims of US. Pat. No. 6,357,448 discloses all that is recited in the instant claims except it may not state that the sheet of tobacco-containing material is flavored with an additive; however, Eilerman et al discloses liquid flavorants (in a solvent solution) that are useful for flavoring tobacco paper (see abstract; col. 3, lines 64-65). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate this flavorant into the shell recited in the claims of US. Pat. No. 6,357,448 in order to provide the tobacco product with a pleasant taste while it is being smoked. Also, while the claims of 6,357,488 may not articulate an "opening between opposing walls" of the package to prevent the sheet from unrolling, such an

opening is obviously present since the claims recite that the cigar tube remains in the rolled tube shape inside the wrapper.

Regarding claim 288, while the claims of 6,357,488 may not articulate an inner and outer surface located between the edges of the sheet, it is obvious that these surfaces are provided in the shell formed by said sheet in order to put tobacco to be smoked therein.

Regarding claims 332-338, while the claims of 6,357,488 modified by Eilerman et al may not recite that the liquid additive includes either oil, propylene, glycerin, benzyl, humectants , botanical extract or any.of the other listed flavors, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate any of the listed items in the tobacco paper of the shell claimed in US. Pat. No. 6,357,448, since these are conventional additives to products in the tobacco art.

3. Claims 279-280 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of U.S. Patent No. 6,357,448 in view of claims 1-4 of US. Pat. No. 6,321,755.

The claims of US. Pat. No. 6,357,448 recites all that is recited in the instant claims except a tube for receiving the material; however, the claims of US. Pat. No. 6,321,755 disclose such a tube in the form of a cylindrical form casing. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate the tube claimed in 6,321,755 around which the sheet material claimed in 6,357,448 can be wrapped so that said sheet material is ensured to maintain its rolled shape.

4. Claims 299-303 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of US. Pat. No. 6,321,755 in view of claims 1-23 of U.S. Patent No. 6,357,448.

The claims of US. Pat. No. 6,321,755 discloses all that is recited in the claims except for it may not explicitly state that the shell is formed from homogenized tobacco paper; however, the claims of US. Pat. No. 6,357,448 discloses a cigar tube which comprises homogenized tobacco paper. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to form the shell claimed in US. Pat. No. 6,321,755 of homogenized tobacco paper since it use in forming tobacco product tubes is known from the claims of US. Pat. No. 6,357,448.

Regarding claim 303, while the claims of US. Pat. No. 6,321,755 may not articulate multiple layers of homogenized tobacco paper, it does recite multiple layers of tobacco leaves. It would have been obvious to one having ordinary skill in the art at the time of the invention to provide multiple layers of tobacco paper, in lieu of tobacco leaves, in order to provide a more study tobacco product.

5. Claims 276-280, 288, 299-303, 306-338 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-22 of copending Application No. 10/090,932 in view of Eilerman et al (US. Pat. No. 5,147,463).

The claims of US. Application No. 10/090,932 discloses all that is recited in the instant claims except it may not state that the sheet of tobacco-containing material is flavored with an additive; however, Eilerman et al discloses liquid flavorants (in a

solvent solution) that are useful for flavoring tobacco paper (see abstract; col. 3, lines 64-65). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate this flavorant into the shell recited in the claims of US. Application No. 10/090,932 in order to provide the tobacco product with a pleasant taste while it is being smoked. Also, while the claims of US. Application No. 10/090,932 may not articulate an "opening between opposing walls" of the package to prevent the sheet from unrolling, such an opening is obviously present since the claims recite that the cigar tube remains in the rolled tube shape inside the wrapper.

Regarding claim 288, while the claims of US. Application No. 10/090,932 may not articulate inner and outer surface located between the edges of the sheet, it is obvious that these surfaces are provided in the shell formed by said sheet in order to put tobacco to be smoked therein.

Regarding claims 332-338, while the claims of US. Application No. 10/090,932 modified by Eilerman et al may not recite that the liquid additive includes either oil, propylene, glycerin, benzyl, humectants , botanical extract or any of the other listed flavors, it would have been obvious to one having ordinary skill in the art at the time of the invention to incorporate any of the listed items in the tobacco paper of the shell claimed in US. Pat. No. 6,357,448, since these are conventional additives to products in the tobacco art.

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 276-280 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding the language in claims 276 and 279, Applicant has claimed a "tobacco shell"; however, the last limitation of the claim recites "a wrapper". It is not clear whether Applicant intended for the claims to be drawn to a "tobacco shell" or a "tobacco product" which comprises a shell and a wrapper. Clarification is requested.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne A. Walls whose telephone number is (703) 305-0933. The examiner can normally be reached on Mon-Fri, 7AM - 4:30PM (Every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven P Griffin can be reached on (703) 308-1164. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

Dionne A. Walls
August 24, 2002